

- (2) Claim 4 under 35 U.S.C. §103(a) over Ying and further in view of Hayes, and further in view of U.S. Patent Application Publication No. 2003/0119478 (Nagy);
- (3) Claims 5 and 21 under 35 U.S.C. §103(a) over Ying and further in view of Hayes, and further in view of U.S. Patent Application Publication No. 2001/0042124 (Barron);
- (4) Claims 11, 13 and 17 under 35 U.S.C. §103(a) over Hayes and further in view of Ying; and
- (5) Claim 14 under 35 U.S.C. §103(a) over Hayes and further in view of Ying, and further in view of Barron.

Claims 1, 11 and 18 are the only independent claims. Applicants submit that the claims are patentable over the applied art.

Claims 1, 11 and 18 are directed to methods and system for font rental. Applicants claimed methods and systems provide for control of the degree to which an end user can access a font and how long the font is available to the user. This is distinct from a method or system of purchasing or licensing fonts on a permanent or perpetual basis or sampling of fonts prior to purchase. Cost to the end user is less since the user is not required to purchase

more than what is needed while providing the consumer with sufficient access to complete a desired use. The receipt of a requested font and enforcement of a limited rental term are part of the claimed methods and systems. Claims 1, 11 and 18 specifically require that a requested font is provided for a predetermined period of time and for a predetermined use access based on subscription information provided by a font consumer, that the requested font is tracked so that the time and use of the requested font conforms to the predetermined period of time and access, and that the requested font is disabled upon expiration of the predetermined period of time. The applied art does not teach or suggest applicants' methods and systems for font rental as claimed.

Of the applied references, only Ying and Hayes are applied as to independent claims 1, 11 and 18. Nagy is applied (in combination with Ying and Hayes) only in relation to the added limitation of dependent claim 4. Barron is applied (in combination with Ying and Hayes) only in relation to the added limitation of dependent claims 5, 14 and 21. Applicants respectfully submit that the primary references of Ying and Hayes do not render independent claims 1, 11 and 18 obvious within the meaning of 35 U.S.C. §103.

The Examiner acknowledges at page 5 of the outstanding action that Ying fails to disclose that the required font is tracked so that upon expiration of the predetermined time period, the font is disabled but relies on Hayes for this teaching. At page 11 of the outstanding action, the Examiner further acknowledges that Hayes fails to specifically disclose providing information defining a predetermined time period of use where the font tracker disables the demanded font after expiration of the predetermined period of time.

Ying does not teach a method or system for distributing or managing fonts by rental involving the combination of features as claimed by applicants. Ying provides no description as to how to provide or implement or enforce a license or sale including limitations. Applicants claim particular methods and systems for distributing or managing fonts specifically on a rental basis.

Hayes describes a system and method for examining font files for corruption. To the extent Hayes describes sale of fonts, such involves the sale of a group of fonts or individual fonts. The sale may include a sampling period so that a user can sample a font prior to purchase. However, thereafter the user is prompted to purchase the font. A method or system for renting a desired font for a

predetermined period of time and access is not described. Only a preview and purchase system, i.e., a sales system, is described. A preview or sampling by its nature provides a limited "taste" or use of the article of commerce sought to be sold. It is limited so that a complete access or use is not provided or available, otherwise there would be no need to purchase the article, which as taught by Hayes is the purchase, i.e., sale, of fonts. The Examiner while recognizing that Hayes fails to disclose providing of information defining a predetermined period of use where the font tracker disables the demanded font after expiration of the period of use, relies on the teaching in Hayes of a sample or preview period and asserts that it would be obvious to modify Hayes to provide the invention as claimed. Applicants disagree in that the modification necessary is beyond the teaching or suggestion of Ying or Hayes. Neither Ying nor Hayes describes, and provides no basis for suggestion of, method or system steps providing for rental of fonts.

The claims provide for accessing or providing subscription information which determines the predetermined period of access for use of the fonts. This time period, as claimed, allows for the provision and installing of a requested font by the consumer and use of the font by the

consumer. Accordingly, the invention as claimed has a different purpose and is defined by specific features to achieve that purpose that are not taught or suggested by Ying or Hayes.

For a proper rejection, the invention as claimed must be determined to be obvious from a fair reading of the prior art as a whole and requires a comparison of the subject matter claimed with the prior art as a whole. In re Gordon, 221 USPQ 1125, at 1127; In re Rothermel and Waddell, 125 USPQ 328, at 331-332; and In re Aufhauser, 158 USPQ 351, at 353. In the case at hand, there is nothing in the individual references which suggests the specific combination of the claims providing methods and systems for font rental. A rejection under 35 U.S.C. §103 must rest on a firm factual basis and deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupportable generalities. In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967) and In re Freed, 425 F.2d 785, 165 USPQ 570 (CCPA 1970), or applicants' teaching.

Accordingly, Hayes and Ying do not render the claimed methods and systems for font rental obvious within the meaning of 35 U.S.C. §103.

As set forth above, Nagy is applied solely with respect to the limitation of claim 4 as to debiting an

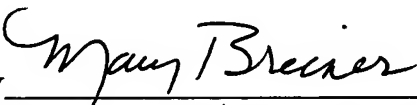
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account of a consumer and Barron is applied solely with respect to the limitation in dependent claims 5, 14 and 21 as to encrypting or decrypting a font. Nagy provides no teaching or suggestion as to a method or system for distributing or managing fonts on a rental basis as claimed by applicants. Further, Barron provides no teaching or suggestion as to a method or system for distributing or managing fonts on a rental basis as claimed by applicants. Thus, neither Nagy nor Barron make up for the shortcomings of Ying and Hayes.

Accordingly, withdrawal of the §103 rejections is, therefore, respectfully requested. Reconsideration and formal allowance of the claims are respectfully requested.

Respectfully submitted,

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